



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,258	07/26/2006	Akihiko Fujii	293717US0PCT	6672
22850 7590 12/24/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KING, FELICIA C	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 12/24/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,258	<b>Applicant(s)</b> FUJII ET AL.	
	<b>Examiner</b> FELICIA C. KING	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/26/06, 9/29/06, 10/24/06, 1/10/07, 11/15/07.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 2 recites the limitation "the analysis" in lines 1 and 2 of claim 2. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 5 recites the limitation "the analysis" in lines 2 and 3 of claim 5. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 7 recites the limitation "the zinc chloride method or steam activation method" in lines 2 and 3 of claim 7. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102/103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1794

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**10. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stelkens (GB 354,942).**

11. **Regarding Claim 1:** Stelkens discloses a coffee composition where poisonous substances are removed [page 1, lines 12-26 and Page 1, lines 95-106]. The coffee grounds in Stelkens are treated using a very similar process as in the instant

Art Unit: 1794

specification [See instant Application Example 7] and as such would be expected to produce a coffee composition having significantly reduced levels/removal of the poisonous substance HHQ. Stelkens and Example 7 in the instant application both take coffee grounds and activated carbon and mix them together, water is added and then the mixture is filtered.

12. Alternatively, because Stelkens uses a similar activated chloride method as discussed in the instant claim, it would have been obvious that the treatment of coffee grounds with activated carbon would result in a coffee product having significantly reduced levels/removal of poisonous substances such as HHQ and to continue to reduce the levels of undesirable chemicals such as HHQ in coffee by using the activated carbon method, until the desired level/removal of the poisonous substance was obtained. Stelkens' failure to specifically recite the removal of the named substance HHQ does not negate the fact that a poisonous substance such as HHQ is removed by the activated carbon method.

**13. Regarding Claim 2:** Stelkens discloses a coffee composition treated in a similar manner as described above and as such the coffee composition would be expected to have similar characteristics or properties when analyzed by HPLC as described in the instant claim.

14. Alternatively, because Stelkens discloses a coffee composition treated in a similar manner as discussed in the instant claim, it would have been obvious that the coffee composition would have similar properties when analyzed by HPLC as the coffee composition in the instant claims.

Art Unit: 1794

15. **Regarding Claim 6:** Stelkens discloses treatment via activated carbon [lines 96-99].

16. **Regarding Claim 7:** Stelkens discloses carbon activated by the zinc chloride method [lines 96-100].

***Claim Rejections - 35 USC § 103***

17. **Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stelkens (GB 354,942) in view of Schlichter (US Patent Number 3,615,666).**

18. **Regarding Claim 3:** Stelkens discloses a coffee composition treated to remove poisonous materials as discussed above but does not disclose a soluble coffee composition. However, Schlichter discloses a soluble coffee composition [col. 1, lines 4-9].

19. At the time of the invention it would have been obvious to one of ordinary skill in the art having the teachings of Stelkens and Schlichter before him or her to modify the composition of Stelkens to include a soluble coffee composition as in Schlichter because it provides an faster alternative to the traditional brewed coffee as desired by consumers.

20. **Regarding Claim 8:** Stelkens discloses the coffee composition as discussed above but do not disclose spray drying or freeze drying the composition. However, Schlichter discloses a composition made by freeze drying or spray drying [col.3, lines 51-55].

21. At the time of the invention it would have been obvious to one of ordinary skill in the art having the teachings of Stelkens and Schlichter before him or her to modify the

Art Unit: 1794

composition of Stelkens to include a soluble coffee composition as in Schlichter because it provides an faster alternative to the traditional brewed coffee as desired by consumers.

**22. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stelkens (GB 354,942) in view of Behrman (US Patent Number 2,430,663).**

**23. Regarding Claim 4:** Stelkens discloses a coffee composition as discussed above but does not specify providing the coffee in a package. Behrman discloses a packaged dry coffee composition [col.1, lines 6-10].

**24.** At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Stelkens and Behrman before him or her to modify the coffee composition of Stelkens to include a packaging mechanism because it maintains the qualities and flavors of coffee [Behrman col.1, lines 24-27].

**25. Regarding Claim 5:** Stelkens discloses a coffee composition and as such would be expected to have similar properties as analyzed by HPLC as discussed above and Behrman discloses packaging the coffee product as discussed above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FELICIA C. KING whose telephone number is (571)270-3733. The examiner can normally be reached on Mon- Thu 7:30 a.m.- 5:00 p.m.; Fri 7:30 a.m. - 4:00 p.m. alternate Fridays off.



Art Unit: 1794

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/FELICIA C KING/  
Examiner, Art Unit 1794

/Jennifer McNeil/  
Supervisory Patent Examiner, Art Unit 1794